GP1635

Docket No. 62574-A/JPW/GJG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#13/R.T. 10/31

ELECTION

Applicant : Ulrich Laemmli and Samuel Janssen

Serial No.: 09/903,359 Examiner: J. Epps-Ford

Filed : July 11, 2001 Group Art Unit: 1635

For : LINKED SEQUENCE-SPECIFIC DNA BINDING MOLECULES

1185 Avenue of the Americas
New York, New York 10036
October 25, 2002

Assistant Commissioner for Patents
Washington, D.C. 20231

SIR:

RESPONSE TO SEPTEMBER 26, 2002 RESTRICTION REQUIREMENT

This is a Response to the Restriction Requirement issued September 26, 2002 in connection with the above-identified application. Accordingly, a response to the September 26, 2002 Restriction Requirement is now due October 26, 2002 and this Amendment is being timely filed.

Claims 1-5, 51-57, 69-72, 79-82 and 85 are pending in the subject application.

In the September 26, 2002 Restriction Requirement, the Examiner required restriction to one of the following allegedly distinct inventions as follows:

I. Claims 1-5, 71-72, and 79-82, drawn to a DNA-binding molecule;

II. Claims 69-70, drawn to a process for modulating the function of a DNA element, or chromosome function; and

III. Claims 51-57 and 85, drawn to a process for binding double-stranded DNA in a sequence-specific manner, to the use of a DNA-binding molecule that is fluorescently labeled for chromosome visualization and marking in diagnosis.

The Examiner alleged that the inventions are distinct, each from the other, alleging Inventions I and II-III are related as product and process of use. The Examiner stated that inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP §806.05 (h)). In the instant case the Examiner alleged that the DNA-binding molecules (specifically referring to oligopyrroles, on page 49 of specification) of invention I can be used to inhibit the ability of topoisomerase II to cleave nucleic acid in a sequence specific fashion. The Examiner also alleged that groups II-III are drawn to patentably distinct inventions. The methods of groups II-III are drawn to distinct methods, comprising distinct objectives, materials, method steps, and distinct outcomes.

Alleging these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, the Examiner asserted that restriction for examination purposes as indicated is proper.

In response, applicants hereby elect, with traverse, Group I, claims 1-5, 71-72 and 79-82.

Applicants traverse on the basis that all of the process of use claims of Groups II and III, as identified by the Examiner, depend on and incorporate the limitations of product claim 1 of elected Group I. While applicants note the Examiner's reliance on M.P.E.P. § 806.05(h) to restrict the product from its use, applicants respectfully point out that the relied upon section does not address how to treat such claims once the product claim is allowed. M.P.E.P. § 806.05(i) addresses how to treat such claims once the product claim is allowed:

> Where the product claims are allowable (i.e., novel and nonobvious), restriction may be required only where the process of making and the product made are distinct (MPEP § 806.05(f)); otherwise, *the process of using must be joined with the process of making and product made, even if a showing of distinctness can be made between the product and process of using* (MPEP § 806.05(h)). (Emphasis added)

Indeed, such treatment of the claims is rational in view of the minimal burden on the Examiner to examine process of use claims which incorporate all of the limitations of an allowed product claim.

Furthermore, claim 1 is a linking claim that links the inventions of Groups I, II and III according to M.P.E.P. § 809.03. Pursuant to M.P.E.P. § 809.04 "*[I]f a linking claim is allowed, the examiner must thereafter examine* species if the linking claim is generic thereto, or he or she must examine *the claims to the nonelected inventions that are linked* to the elected invention

by such allowed linking claim." (Emphasis added). Therefore, applicants hereby respectfully request that the Examiner examine the nonelected invention of Groups II and III once the linking invention of Group I is found allowable.

Yet furthermore, applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement under 35 U.S.C. §121, which states that restriction may be required if two or more independent and distinct inventions are claimed in one application. Under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden.

The inventions of Groups I, II and III are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subjects disclosed. The inventions of Groups II and III are drawn to a process of using the DNA-binding molecules of Group I. Applicants therefore maintain that the Groups are not independent and restriction is not proper.

Finally, under M.P.E.P. § 803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: 1) the invention must be independent and distinct, **and** 2) there must be a serious burden on the Examiner if restriction is not required. Applicant respectfully submit that there would not be a serious burden on the Examiner if restriction is not required, because, as alluded to above, a search of the prior art relevant to any of the claims of Group I would necessarily turn up the prior art relevant to the use of the product, i.e. the art would be

relevant to the invention of Groups II and III. Since there is no burden on the Examiner to examine Groups I-III together in the subject application, the Examiner must examine the entire application on the merits.

In view of the foregoing, applicants maintain that restriction is not proper under 35 U.S.C. § 121 and respectfully requests that the Examiner reconsider and withdraw the requirement for restriction. At minimum, applicants hereby request that the Examiner return to examine all of the pending non-elected claims which depend on and incorporate the limitations of an allowable claim.

No fee is deemed necessary in connection with the filing of this Response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

10/25/02
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